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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/518,554	03/03/2000	Jacob Vroman	AIMPORT.011A	7420
32254	7590	02/06/2006	EXAMINER	
KEOWN & ASSOCIATES 500 WEST CUMMINGS PARK SUITE 1200 WOBURN, MA 01801			SHEIKH, HUMERA N	
			ART UNIT	PAPER NUMBER
			1615	
DATE MAILED: 02/06/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/518,554	<b>Applicant(s)</b> VROMAN, JACOB	
	<b>Examiner</b> Humera N. Sheikh	<b>Art Unit</b> 1615	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 23,24,27-32 and 36-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23,24,27-32 and 36-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### **Status of the Application**

Receipt of the Request for Continued Examination (RCE) under 37 C.F.R. §1.114, the Amendment and Applicant's Arguments/Remarks, all filed 10/31/05 is acknowledged.

Claims 23, 24, 27-32 and 36-45 are pending in this action. Claim 23 has been amended. Claims 1-22, 25, 26 and 33-35 have previously been cancelled. Claims 23, 24, 27-32 and 36-45 are rejected.

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/31/05 has been entered.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29

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USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 23, 24, 27-32 and 36-45 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 26-45 of copending Application No. 09/562,778 in view of Siddiqui (US Pat. No. 6,146,664) ('664 Patent).

The instant invention is drawn to a method of providing one or more of the following treatments to a mammal in need of such treatment: UV protection, decrease or alleviation of wrinkles, or stimulating collagen production in a mammal, said method comprising: identifying a mammal in need of such treatment, and topically applying to said mammal a composition comprising at least 30% L-ascorbic acid, by weight, micronized in an oil selected from caprylic triglycerides, capric triglycerides, isostearic triglycerides, adipic triglycerides, propylene glycol myristyl acetate, lanolin oil, polybutene, isopropyl palmitate, isopropyl myristate, diethyl sebacate, diisopropyl adipate, hexadecyl stearate, cetyl oleate, oleyl alcohol, hexadecyl alcohol, wheat germ oil, vegetable oils such as castor oil, corn oil, cottonseed oil, olive oil, palm oil, coconut oil, palm kernel oil, canola oil, sunflower oil, safflower oil, meadow foam oil, jojoba oil, hydrogenated vegetable oils and mineral oil, a non-aqueous carrier selected from esters, amides, ethoxylated fats, mineral oil, petrolatum, vegetable oils, animal fats, triglycerides, polyols

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including glycerol, propylene glycol, glycerin and sorbitol, and an exfoliant, wherein the mean particle size of the L-ascorbic acid is no greater than approximately 5  $\mu\text{m}$ .

The copending '778 application is drawn to a composition for topical use comprising greater than approximately 25% micronized L-ascorbic acid, by weight, a non-aqueous carrier, and an exfoliant, wherein the exfoliant is an enzyme. The copending '778 application is also drawn to a method for preparing a topical L-ascorbic acid composition comprising micronizing ascorbic acid powder in an oil, and adding an exfoliant wherein the resultant composition comprises greater than approximately 25% L-ascorbic acid by weight and wherein the exfoliant is an enzyme.

Similar subject matter has been claimed in each of the applications. While the copending '778 application does not set forth the particular use of the ascorbic acid composition, such as for use in UV protection, decrease or alleviation of wrinkles, or stimulating collagen production, as claimed in the instant application, it is the position of the Examiner that it would have been deemed obvious to one of ordinary skill in the art at the time the invention was made to formulate a topical ascorbic acid-containing formulation in combination with additional components (*i.e.* exfoliants) for use in the effective treatment of skin conditions, particularly for providing UV protection, alleviation of wrinkles and/or increasing collagen production.

The secondary reference of Siddiqui ('664 Patent) is relied upon for the teaching of stable topical ascorbic acid compositions wherein ascorbic acid provides a high degree of bioavailability and effectiveness for topical applications to reduce wrinkles and increase collagen growth and elasticity (see Abstract). Also see Table 5 at column 7, wherein the data in Table 5 clearly demonstrates that the ascorbic acid product is effective at improving skin elasticity and

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the appearance of fine lines and wrinkles. The data represents a dramatic improvement in the amounts of collagen in the skin that results in increased skin elasticity and a simultaneous improvement in skin texture (*i.e.*, reduction in fine lines and wrinkles).

Therefore, it is the position of the Examiner, that given the teachings of Siddiqui ('664) delineated above, it would be *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to formulate stable, topical ascorbic acid compositions for use in effectively reducing wrinkles, improving skin appearance/texture and increasing collagen productivity to a person in need thereof. The expected result would be an optimally enhanced method for the treatment of skin conditions in a human.

This is a provisional obviousness-type double patenting rejection.

### ***Response to Arguments***

Applicant's arguments, see 'Remarks' section, pages 4-7, filed 10/31/05, with respect to art rejections have been fully considered and are persuasive. The finality of the 35 U.S.C. §103(a) rejection of claims 23, 24, 27-32 and 38-45 over Siddiqui ('664), the 35 U.S.C §103(a) rejection of claims 23, 24, 27-32 and 36-45 over Siddiqui in view of Ozlen ('740) and the 35 U.S.C §103(a) rejection of claims 23, 24, 27-32 and 38-45 over Hernandez *et al.* ('411) has been withdrawn by virtue of Applicant's amendment.

### Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Humera N. Sheikh whose telephone number is (571) 272-0604. The examiner can normally be reached on Monday through Friday from 8:00A.M. to 5:30P.M., alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Humera N. Sheikh

Patent Examiner

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February 01, 2006

  
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*hns*